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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Paul Lapstun

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

CHEN, HUO LONG

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

10/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/786,631	Applicant(s) LAPSTUN ET AL.	
	Examiner HUO LONG CHEN	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 58-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 58, 60-64 is/are rejected.
- 7) ☐ Claim(s) 59 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/15/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

With respect to claim 64, "A method according to claim 61, the method being a method according to claim 58", Examiner does not understand if the claim 64 depends on claim 61 or claim 58. Appropriate explanation is required

Nonstatutory Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective from January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 58 and 60 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15 and 16 of U.S. Patent No.

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7,111,791. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

The limitations of the instant **claim 58** are substantially identically in lines of 1-24 of Patent claim 15. Although the claim lines of 6-8 of U.S. Patent No. 7,111,791 and the lines of 8-10 illustrate the layout of the coded data with different sentence structure, both of them give the same limitation to the layout of the coded data which has mirror symmetry, n-fold rotational symmetry. The claim 15 of U.S. Patent No. 7,111,791 fails to disclose "rotational symmetry about a center of rotation", but it is obvious to have the rotational symmetry which is about a center of a rotation because it is well known that a symmetry of a rotation could be a center.

With respect to **claim 60**, which further limits claim 58, the limitations of the instant claim 60 are identically in lines 1-3 of Patent 16.

4. Claims 59 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15 of U.S. Patent No. 7,111,791 in view of Wright et al. (US 4,900,904).

With respect to **claim 59**, which further limits claim 58, the U.S. Patent No. 7,111,791 fails to claim that the coded data is being printed with the invisible ink.

Wright et al. teach that the code information can be printed with ink that is invisible in the normal light spectrum (col.12, lines 47 and 48).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the inventions of the U.S. Patent No. 7,111,791 and

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Wright et al. because printing the code with the invisible ink will enhance the security of the coding information.

5. Claims 61-63 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-16 of U.S. Patent No.7, 334,739 in view of Hall et al. (US 2002/0088064). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

The limitations of the instant **claim 61** are substantially identically in lines of 1-14 of Patent claims 15. Although the claims 15 of U.S. Patent No. 7,334,739 fail to disclose “each sub-layout encoding a codeword formed from a number of data elements”, Hall et al. teach that the four codewords can be arranged so that each tag orientation contains one codeword placed at that orientation, as shown in FIG. 6d (paragraph 171) and Each tag encodes the page ID, tag ID, and controls bits (paragraph 585). Therefore, it would have been obvious to one of the ordinary skill in the art to modify the U.S. Patent No. 7, 334,739 according to Hall et al. because the tags are error-correctably encoded to make them partially tolerant to surface damage.

With respect to **claim 62**, which further limits claim 61, the limitations of the instant claim 62 are identically in lines 1-2 of Patent 16.

With respect to **claim 63**, which further limits claim 61, the limitations of the instant claim 63 are identically in lines 1-4 of Patent 17.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUO LONG CHEN whose telephone number is

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(571)270-3759. The examiner can normally be reached on 8:00am to 5:00pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark K. Zimmerman can be reached on (571)272-74653. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Huo Long Chen/
Patent Examiner

/Mark K Zimmerman/

Supervisory Patent Examiner, Art Unit 2625